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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/072,412	05/04/1998	STEPHEN R. SCHWARTZ	15381	6519

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EXAMINER
PENDLETON, BRIAN T

ART UNIT	PAPER NUMBER
2644	

DATE MAILED: 01/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/072,412	SCHWARTZ, STEPHEN R.	
	Examiner	Art Unit	
	Brian T. Pendleton	2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 October 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25 and 27* is/are pending in the application.

4a) Of the above claim(s) *6-12 and 16-27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 13-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Election/Restrictions

Applicant's election with traverse of group I, claims 1-5 and 13-15 (Applicant erroneously omitted 13-15) in Paper No. 13 is acknowledged. The traversal is on the ground(s) that there is no showing of burden to the Examiner, that the claims are part of the same class, and that the case was fully examined prior to the restriction requirement. This is not found persuasive because:

1. Restriction is proper at any time. See MPEP section 811.

2. Although claims are part of the same class they have different status in the art and,

3. The burden to the Examiner lies in their separate status and subclasses. Furthermore, Applicant relies on a "basic premise" argument to show that the claims are not distinct. However, "basic premise" is not restricted; claims are restricted.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 and 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant recites "playing reference sounds of the instrument" in claim 1 and "reference sounds directly from said type of musical instrument". The term 'reference sound' is both vague and unclear in light of the specification. Page 9 of the specification gives three definitions of reference sounds

including the sound of an instrument being played and listened to in its normal environment, the sound picked up by a reference microphone and the sound recorded on a storage device. Having three definitions of reference sounds deems the claims vague and indefinite.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 and 13-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant claims comparing the 'reference sounds' of a musical instrument to those picked up by a microphone. However, one of ordinary skill is not provided the knowledge to accomplish such task. For example, if the reference sounds were sounds of an instrument in its normal listening environment, it is not explicitly disclosed how that sound can be compared to the sound inputted to the microphone and an equalizer designed accordingly.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeap, US Patent 4,118,601. Yeap discloses a system for equalizing an audio system comprising a noise generator 28, equalizer 10, speaker 16, and microphone 30. The noise generator 28 generates a test signal which is applied to the equalizer 10 and outputted through the speaker 16. The microphone 30 picks up the emitted sound and the equalizer 10 uses the comparators 46, filters 40 and attenuators 42 to equalize the test signal to that which is picked up by the microphone (see abstract and column 2 line 46 – column 4 line 46). Therefore, a tailor-made equalizer is made to compensate for the difference between a reference sound (the test signal) and how that sound is picked up at a listening position. It would have been obvious to one of ordinary skill in the art at the time of invention to apply the method of Yeap to musical instruments, since it was well known that such instruments are subject to equalization due to room acoustics, amplification, etc. Thus, claims 1 and 13 are met. Per claims 2 and 14, it was well known to attach microphones to instruments. As to claims 3-4, inherently an user would be listening to the sounds. Regarding claim 5, Yeap discloses adjustment ranges. Per claim 15, it was well known to use digital filters in place of analog filters.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Morton, US Patent 4,306,113.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian T. Pendleton whose telephone number is (703) 305-9509. The examiner can normally be reached on M-F 7-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Brian Tyrone Pendleton
December 31, 2001